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Steve Sorem

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EXAMINER

DAGNEW, SABA

ART UNIT

PAPER NUMBER

3688

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,250	Applicant(s) SOREM, STEVE	
	Examiner SABA DAGNEW	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 May 2009 has been entered.

Claim Objections

The claims 1, 25, 44, 50, 59, 60 and 61 are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims should begin with a new line and one and one-half or double spaced on good quality paper are required. (See 37 CFR 1.52(b)).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 44-58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine (such as a computer or device) (see *Bilski*, 545 F. 3d 943, 88 USPQ2d 1385 (Fed Cir. 2008) and (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S.

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780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **61-69** are rejected under 35 U.S.C. 102(e) as being anticipated by **Walker et al. (U.S. Patent No. 6,138,106)**.

With respect to claim 61, Walker teaches a transaction processing and tracking system comprising:

at least one front-end service providing at least one product bearing a code that uniquely identifies said product (***Col. 2, lines 51-53, which teaches receiving data identifying the first product code***);

at least one back-end service communicatively coupled to said at least one front-end service (**Col. 4, lines 1-5**, which teaches a communication link between personal computer (front-end) and Central controller (back-end) via internet) ; and,

at least one account, associated with a user, including at least one pre-defined purse suitable for use in the transaction, wherein said at least one account is communicatively coupled to said at least one front-end service (**Fig. 7A**, which teaches user/buyer log-on 114, and receiving user/buyer information including credit card number (account) and **Col. 5, lines 4-14**, which teaches establishing an account for user/buyer);

wherein said at least one product is transacted in exchange for multiple resource types included in said account by interacting with said account in accordance with an agreed value of said at least one product (**Col. 7, lines 30-45**, which teaches processing pre-paid gift certificate (product) and transmitting transaction to a credit card issuer for authorization); and

wherein said at least one product is exchanged for multiple ones of the multiple resource types, and accordingly said account is interacted with (**Col. 7, lines 30-45**, which teaches processing pre-paid gift certificate (product) and transmitting transaction to a credit card issuer for authorization and **Col. 8, lines 58-66**, which teaches pre-paid gift certificate value redeemed and track and charged appropriately to the various authorized account).

With respect to claims 62 and 63, Walker in view of Humble teaches all elements of claim 61, furthermore, Walker teaches the method, wherein the

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communicative coupled comprises a known communication network (**Col. 4, lines 1-5**, *which teaches connecting via internet (network)*).

With respect to claim 64, Walker teaches the system wherein said at least on front-end service includes at least one of merchant financial resource, service providers, and business partners (**Col. 7, lines 46- 49**, where "bank" reads on financial resource).

With respect to claim 65, Walker teaches all elements of claim 61, furthermore, Walker teaches the method wherein said at least one back-end service includes at least one of a server and software resource (**Col. 4, lines 1-22**, where "buyer/redeemer interface" reads on software and **Col. 4, lines 37-43**, teaches "control programs and Certificate redemption program" reads on software and server is inherent) and consumer account (**Col. 5, lines 4-8**, which teach account established).

With respect to claim 66-69, Walker teaches all elements of claim 61, furthermore, Walker teaches wherein transactions include value based transactions, interacting includes debit, credit (**Col. 4, line 67, and Col. 5, 1-3**, which teaches debit and credit transaction) and value chaining (**Col. 11, lines 19-20**, which teaches direct refund) .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-17, 24-25, 28-38, 44-50, and 54-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Walker et al. (U.S. Patent No. 6,138,106) in view of Humble (US Patent No. 4,949,256)**.

With respect to claims 1, 25, 44, 50 and 59-60 Walker teaches a method for tracking promotion at least one group products, a remote station for tracking valuation, a system, and method of at least one of a group of products, each of which bears a code that uniquely identifies each product in the group, method comprises:

communicatively coupling a remote station to a user station (**Fig. 1, and Col. 4, lines 1-12**, where “personal computer” reads on user station and “central controller 2” reads on a remote station);

providing a database at the remote station (**Fig. 2, teaches four databases 26-32 Fig. 3 and Col. 4, lines 23-27**, where “central controller 12” connected to “storage device” reads on database);

storing in the database ones of the uniquely identifying codes that have been previously received from one or more user stations (**Fig. 4, where “item code” reads on uniquely identifying code and Col. 2, lines 40-67**, where teaches processor receiving data identifying the first product code).

Walker teaches all the above elements except comparing each new candidate code received from a given user station against the previously received codes stored in

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the database, crediting an account of a user associated with the given user station with a non-zero promotional credit when such new candidate code received from the given user station was not previously stored in the database and storing such new candidate code in the database as a previously received code if such new candidate code was not previously stored in the database.

However, Humble teaches comparing each new candidate code received from a given user station against the previously received codes stored in the database (**Col. 4, lines 10-21**, *which teaches reading (receiving) encoded card that uniquely identifies coupon, compare received coupon with a local file (database) of redeemable coupons*) and crediting an account of a user associated with the given user station with a non-zero promotional credit when such new candidate code received from the given user station was not previously stored in the database (**Col. 3, lines 32-42**, *which teach crediting customer account for later use and 54-67, which teach compare received coupon with local file and accumulating credit value*) and storing such new candidate code in the database as a previously received code if such new candidate code was not previously stored in the database (**Col. 4, lines 1-5**, *updating local database by adding coupons, where "presented and validated" reads on received new candidate code*) . Therefore, it would have been obvious to the one ordinary skills in the art at the time of the invention was made to add coupon validation network as taught by Humble in the system of Walker in order to validate coupon automatically for later redemption credit (see Humble, **Col. 2, lines 56-59**).

With respect to claim 2, Walker in view of Humble teaches all elements of claim 1, furthermore, Walker teaches the method wherein said database further includes at least one permissible new candidate code (**Fig. 2, 28**, which teaches gift certificate code database **and Fig. 5**, code number 72, allowable candidate code), and

wherein the at least one permissible new candidate code may be provided by a provider of the ones in the group (**Fig. 7A, 128 and Col. 6, lines 23-34**, where teaches "merchant been established gift items" candidate code may be provided by provider **Col. 6, lines 65-67**, where "a gift code central controller 12" reads on provider provided a gift code **and Col. 7, lines 1-5**) and

wherein said database server compares each new candidate code against the at least one permissible new candidate code (**Col. 11, lines 35-47**, which teaches examine to identify records)

With respect to claims 3 Walker in view of Humble teaches all elements of claims 1 and 2, furthermore, Walker teaches the method wherein the non-zero valuation credit may be not credited if the new candidate code doesn't match one of the at least one permissible new candidate codes (**Fig. 7A, 140**, which teaches credit card code doesn't match, it passes an error message such as "invalid account")

With respect to claims 4, and 9, Walker in view of Humble teaches all elements of claims 1 and 3, furthermore, Walker teaches the method wherein there are at least two groups, and wherein each group may be provided by a different provider (**Fig. 5, 82**, multiple seller ID number shows that there are more than provider) .

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With respect to claims 5, and 10 Walker in view of Humble teaches all elements of claims 1, 2, 3, 4 and 9, furthermore, Walker teaches the method wherein said database server maintains separate previously received codes and separate permissible new candidate codes for each provider (**Fig. 2, and Col. 4, lines 23-35, which teaches maintaining a separate database**).

With respect to claims 6 and 32, Walker in view of Humble teaches all elements of claims 1 and 25, furthermore, Walker teaches the method wherein said database may be resident on a network server at the remote station (**Fig. 2, and Col. 4, lines 23-43, which teaches storage device 22, contain for databases**) .

With respect to claims 7, and 33, Walker in view of Humble teaches all elements of claims 1, 6, 25, 32 and 61, furthermore, Walker teaches the method, wherein the communicative coupling may be an internet connection (**Col. 4, lines 1-5, which teaches connecting via internet**).

With respect to claim 8, Walker in view of Humble teaches all elements of claim 1; furthermore, Walker teaches the method wherein said database server includes one account associated with each user to correspond to one group for the crediting of the non-zero valuation credit (**Col. 11, lines 18-26, where "direct refund" reads on crediting non-zero valuation credit**)

With respect to claims 11, 34, 46 and 55, Walker in view of Humble teaches all elements of claims 1, 25, 44 and 50, furthermore, Walker teaches the method wherein said database server, upon storing a previously received code, further stores the

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previously received code as a consumed code (**Fig. 5 and Col. 5, lines 48-55, which teaches gift certificate "filled/redeemed" reads on consumed**)

With respect to claims 12, 35, 47 and 56 Walker in view of Humble teaches all elements of claims 1, 11, 25, 34, 44, 46, 50 and 55, furthermore, Walker teaches the method wherein the consumed code cannot be entered as a previously received code by a subsequent user (**Col. 8, lines 5662, which teaches cancelling as expired**).

With respect to claims 13-17, and 36-38 Walker in view of Humble teaches all elements of claims 1 and 25 Walker teaches a method wherein the uniquely identifying code may be a UPC, SPIF, numeric, alphabetic and alpha-numeric (**Fig. 4, 62, where "item code" reads on unique code, which is numeric Fig. 5, 72, where teaches alpha-numeric code**) .

With respect to claim 24, Walker in view of Humble teaches all element of claim 1, furthermore, Walker teaches the method wherein a credit certificate may be issued to the user account once a pre set value of non-zero valuation credits may be accumulated in the user account (**Col. 8, lines 56-64, where "redeemer/user submit accumulated initial code value" reads on non-zero valuation credit may be accumulated**).

With respect to claims 28, 48 and 57, Walker in view of Humble teaches all elements of claim 25, 44 and 50, furthermore, Walker teaches the method wherein said database further includes at least one permissible new candidate code, and wherein the at least one permissible new candidate code may be provided by a provider of the

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certificates in the group (**Col. 8, lines 8-19, which teaches gift certificate code generated and mailed to customer by the credit card issuer**) and wherein said database server compares each new candidate code against the at least one permissible new candidate code (**Col. 8, lines 12-19, which teaches direction are provided, where customer to contact to activate the code, and the controller compares and issue authorization**).

With respect to claim 29, Walker in view of Humble addressed by the rejection of claim 3 as cited above.

With respect to claim 30-31, Walker in view of Humble addressed by the rejection of claims 4 and 5 as cited above.

With respect to claims 45 and 54 Walker in view of Humble teaches all elements of claims 44 and 50, furthermore, teaches Walker the method of further comprising receiving at the remote station from the user station the new candidate code prior to said comparing (**Col. 3, lines 4-8, which teaches receiving data identifying product code**).

With respect to claim 49, Walker in view of Humble addressed by the rejection of claim 3 as cited above.

With respect to claim 58, Walker in view of Humble addressed by the rejection of claims 1 and 2 as cited above.

Claims 18-22, 26-27, 39-42, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,138,106) in view of Humble (US Patent No. 4,949,256) and further view of Official Notice.

With respect to claim 18, Walker in view of Humble teaches all elements of claim 1, except new candidate code may be placed under a peel off label. However, the examiner takes an official notice that it's old and well known in the art to place a product code under peel off label to remove the label from the product easily. For example, peeling off the piece of paper affixed from the product. Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invention to add a peel of label feature in order to remove the code from the product.

With respect to claims 19-22 and 39-42, Walker in view of Humble teaches all elements of claims 1 and 25, including a user input device such as a keyboard to type the new candidate code into an internet browser (**Col. 4, lines 1- 5**), but Walker does not explicitly teaches a code reader. However, the examiner takes an official notice that it's old and well known in the art that to have code reader for tracking asset and inventory. Therefore, it would have been obvious to the one ordinary skill in the art at the time of invention to add code reader feature in order to minimize cost.

With respect to claims 26, and 51, Walker in view of Humble teaches all elements of claims 25, and 50 including buyer is a register user (**Col. 6, lines 39-40**) , but Walker does not explicitly teaches that the user may be a retailer. Therefore,

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official notice taken it is well known in the art at the time the invention was made to add seller of the certificate as a customer of the product of the manufacturer because a seller of the gift certificate is allowing its customer to buy a manufacture's product to generate higher revenue and to give flexible process for the redeemer.

With respect to claims 27, Walker in view of Humble teaches all elements of claim 25 and 26, furthermore, Walker teaches the method, wherein the account credited may be a retailer's account, and wherein the non-zero certificate credit may be equivalent to a purchase value for the certificate (**Col. 5, line 1-3, which teaches "a card number stored in being debited for at purchase for a pre-paid certificate)**

With respect to claim 52, Walker in view of Humble teaches all elements of claims 50 and 51, furthermore, Walker teaches the method further comprising exchanging, by the retailer, of at least one product of value equivalent to the gift certificate for the gift certificate, prior to said comparing (**Fig. 5, 70D, which teaches initial value is equal to remaining code value and Col. 2, lines 34-39, where "selecting a gift within a value of the certificate" reads on product value equivalent to the gift certificate)**

With respect to claim 53, Walker in view of Humble addressed by the rejection of claim 27 as cited above.

Claims 23, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,138,106) in view of Humble (US Patent No. 4,949,256) and further view of Dodd (U.S. Patent No. 6, 321, 211).

With respect to claims 23 and 43, Walker in view of Humble teaches all elements of claims 1 and 25, including redeeming and receiving a gift certificate codes via internet (**Col. 8, lines 39-46**). However, Walker in view of Humble does not teach the method wherein a web browser may be resident on the remote station and the user station.

Dodd teaches the method wherein a web browser may be resident on the remote station and the user station (**Col. 3, lines 28-36, which teaches user/gift giver uses browser to select online gift for the recipient**). Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invention was made to add Todd's browser software feature in the system of Walker and Humble in order to click when the hyperlink contacted with the gift server (**Todd, Col. 11, lines 24-25**)

Response to Arguments

Applicant's arguments with respect to claims 1, 25, 44, 50 and 59-61 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued in pages 16-18 that Walker fails to disclose "a database storing a uniquely identifying code", "wherein the database stores ones of the uniquely identifying codes that have been previously received from one or more user station", fails to "indicate where the processor receives the data from and it fails to disclose that the memory stores the first product code".

However, the Examiner respectfully disagrees with the applicants because Walker teaches a database storing a uniquely identifying code (**Col. 2, lines 43-45, where "memory" reads on database and teaches storing plurality of product codes that**

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identifies (uniquely identifies) product), wherein the database stores ones of the uniquely identifying codes that have been previously received from one or more user station and fails to indicate where the processor receives the data from (**Col. 2, lines 51-53, which teaches processor (database) receives data identifying a first product from the first subset of product code**).

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, the following optional claim language in claims 1, 25, 44, 50, 59 and 60 was not given patentable weight:

” when such new candidate code received from the given user station was not previously stored in the database”

While the Examiner addresses the optional limitation in this action, it is the Examiner’s opinion that these limitations do not distinguish the claim from the prior art. See MPEP 2106 II C (Paragraph 4+).

Applicant in page 18 argued that Waller fails to anticipate claim 61, “wherein said at least one product is transacted in exchange for multiple resource type included in said account”.

However, the examiner respectfully disagrees with the applicant because the Examiner interpreted the above limitation as “wherein said at least one product is

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transacted in exchange for multiple resource type included in said account (**Col. 7, lines 30-45**, which teaches processing pre-paid gift certificate (product) and transmitting transaction to a credit card issuer for authorization and **Col. 8, lines 58-66**, which teaches pre-paid gift certificate value redeemed and track and charged appropriately to the various authorized account where "charging to the various authorized account" reads on one product (gift certificate) transacted in exchange for multiple resource).

Since the limitation of claim 61 has been addressed by Walker, the examiner's rejection under 35 USC 102 is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./
Examiner, Art Unit 3688

/Raquel Alvarez/
Primary Examiner, Art Unit 3688